

means for identifying a type of bill based upon unique numeric identifiers contained within said paper bill; and

means for extracting billing information from zones that are pre-defined for said type of bill.

REMARKS

In the May 10, 2002, Office Action, Claims 1, 2, 5, 6, 9, 16, 17, 20 and 21 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent 5,978,780 to Watson in view of U.S. Patent No. 5,168,444 to Cukor et al.

Claims 3, 4, 7, 8, 10-15, 18, 19, and 22-30 were rejected under 35 U.S.C. §103(a) as being obvious over Watson in view of Cukor et al. and in further view of U.S. Patent 5,557,515 to Abbruzzese et al.

Claims 6 and 21 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Claims 6 and 21 have been amended to overcome the rejection under 35 U.S.C. §112, second paragraph. Accordingly, claims 1-30 are presently pending.

Claims 1, 2, 5, 6, 9, 16, 17, 20 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Watson in view of Cukor et al. With respect to independent claims 1, 9 and 16, Applicants respectfully submit that neither Watson nor Cukar et al. whether taken singly or combined, teach or suggest the steps of "scanning at least one paper bill received for said customer to generate electronic image information, extracting

billing information from the electronic image information, and presenting said at least one electronic bill and said extracted billing information representative of said at least one paper bill to the customer." Page 3 of the Office Action dated May 10, 2002 concedes that Watson does not disclose "scanning and viewing" but cites Col. 2, lines 15-25 in Watson as disclosing the step of "presenting said at least one electronic bill and said extracted billing information representative of said at least one paper bill to the customer."

Applicants respectfully disagree, Watson discloses that multiple service establishments provide electronic detailed billing to a personal settlement exchange. Col. 2, lines 7-15. Watson further discloses that a consolidate payment value, representing the obligation of a household to all service establishments, service establishment billing data, and a detailed billing statement for each household is downloaded from the personal settlement exchange to the household's selected bank. The bank then generates a single printed or electronic consolidated household billing statement, which is mailed in lieu of individual statements being compiled, printed, and mailed by each service establishments. Col. 2, lines 15-25. Applicants respectfully submit that Col. 2, lines 15-25 of Watson does not teach presenting at least one electronic bill and extracted billing information representative of at least one paper bill to the customer. Therefore, Applicants respectfully assert that the rejections under 35 U.S.C. §103(a) of independent claims 1, 9, and 16 should be withdrawn because in addition to not teaching the steps of "scanning at least one paper bill received for said customer to

generate electronic image information and extracting billing information from the electronic image information," Watson does not teach or suggest at least the feature "presenting said at least one electronic bill and said extracted billing information representative of said at least one paper bill to the customer."

Page 3 of the Office Action also asserts that although Watson does not teach scanning and viewing, Cukor et al teaches "a system which electronically presents documents comprising of (b) scanning at least one paper bill received for said customer to generate electronic image information (col. 10 lines 9-21), (c) extracting billing information from said electronic image information (col. 11 lines 34-39), and viewing an electronic image, which can be a bill (col. 10 lines 41-43)." The Office Action goes on to state that "at the time the system was made, it would have been obvious to a person of ordinary skill in the art to modify the bill payment system of Watson to include the scanning of Cukor et al. to handle paper bills." According to Cukor et al., however, "an operator calls up the images of the documents one by one on the display monitor and, working from the display monitor, enters such transaction related information as the PRO number..." whereby "after review of the entered information on the display screen, the operator may commit the information to the data file maintained by the host computer." Col. 11 lines 34-46. Applicants respectfully submit that Col. 11, lines 34-39 in Cukor et al. does not teach the step of "extracting billing information from said electronic image information." Therefore, Applicants respectfully assert that the rejections of independent claims 1, 9, and 16 under 35 U.S.C. §103(a) should be withdrawn because Cukor et al.

does not teach or suggest at least the feature "extracting billing information from said electronic image information."

Cukor et al. does not cure the deficiencies of Watson as discussed above with regard to independent claims 1, 9 and 16. Therefore, Applicants respectfully assert that the rejections under 35 U.S.C. §103(a) should be withdrawn because neither Watson nor Cukor et al., whether taken singly or combined, teaches or suggests each feature of independent claims 1, 9 and 16 and hence, dependent claims 2, 5, 6, 17, 20 and 21, respectively.

Furthermore, the invention in Watson relates to a bill consolidation payment aggregation and account payment system, whereby the system is a settlement exchange between households or small businesses and service establishments. The invention in Cukor et al., on the other hand, relates to an integrated system for image processing of documents generated in shipping transactions. Although Cukor et al. teaches scanning images of documents, the invention in Cukor et al. has nothing to do with settling accounts between households or small business and service establishments. Thus, Applicants respectfully submit that the references relate to different subject matter, and therefore, there is no motivation in either of the cited references to modify the teachings of Watson with the teachings of Cukor et al., to obtain the claimed invention. The Federal Circuit has clearly held that "the motivation to combine references cannot come from the invention itself." Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993). MPEP § 2143.01

further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" Applicants submit that only through hindsight would one modify Watson by combining Cukor et al. to meet the limitations of the claims.

In view of the distinctions noted and the advantages attendant thereto, it is submitted that independent claims 1, 9 and 16 clearly distinguish over Watson and Cukar et al., whether taken singly or combined, and are patentable thereover. Claims 2, 5, 6, 17, 20 and 21, which are dependent claims, are believed to be patentable along with respective parent claims.

The Office Action rejected claims 3, 4, 7, 8, 10-15, 18, 19, and 22-30 under 35 U.S.C. §103(a) as being obvious over Watson in view of Cukor et al. and in further view of Abbruzzese et al. With respect to independent claims 13, 24 and 28, neither Watson nor Cukor et al., whether taken singly or combined, teach or suggest at least the step of "extracting billing information from said electronic image information" as discussed above. Additionally, Cukor et al. and Abbruzzese et al. do not cure the deficiencies of Watson as discussed above with regard to independent claims 1, 9, 13, 16, 24 and 28.

Furthermore, as previously stated, the invention in Watson relates to a bill consolidation payment aggregation and account payment system and the invention in Cukor et al. relates to an integrated system for image processing of documents generated in shipping transactions. The invention in Abbruzzese et al., on the other hand, relates to a computerized system and method for work management. Thus, Applicants respectfully

submit that the references relate to different subject matter, and therefore, there is no motivation in either of the cited references to modify the teachings of Watson with the teachings of Cukor et al. and/or Abbruzzese et al. to obtain the claimed invention.

Applicants respectfully submit that the Office Action has pieced together up to three references to teach the claimed invention. However, MPEP § 2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)." MPEP § 2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" Applicants respectfully submit that the references do not provide such a suggestion or motivation.

Applicants respectfully submit that the only motivation to piece together the three references of the Office Action is found in Applicants' own application. Applicants submit that only through hindsight would one modify Watson to meet the limitations of the claims. MPEP § 2141, under the heading 'Basic Consideration Which Apply to Obviousness Rejections,' points out that "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." [See also Hodosh v. Block, Drug Co., Inc., 786 F.2d 1136, 229 USPQ 182 (Fed. Cir. 1986).] The Federal Circuit has clearly held that "the motivation to combine references cannot come

from the invention itself." Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993).

In view of MPEP § 2144.03, absent any teaching or suggestion in the prior art to adapt the teachings of Watson to meet the claimed invention, and because the rejection lacks evidence of a teaching or suggestion that the features would have been obvious to one of ordinary skill, the rejection under 35 U.S.C. §103(a) is improper. Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §103(a) should be withdrawn because neither Watson, Cukor et al. nor Abbruzzese et al., whether taken singly or combined, teaches or suggests each feature of independent claims 1, 9, 13, 16, 24 and 28 and hence, dependent claims 3, 4, 7, 8, 10-15, 18, 19, and 22-30, respectively. Hence, Applicants respectfully submit that the rejection under 35 U.S.C. §103(a) should be withdrawn.

In view of the distinctions noted and the advantages attendant thereto, it is submitted that independent claims 13, 24 and 28 clearly distinguish over Watson, Cukar et al., and Abbruzzese et al., whether taken singly or combined, and are patentable thereover. Claims 3, 4, 7, 8, 10-12, 14-15, 18, 19, 22-23, 25-27, and 29-30, which are dependent claims, are believed to be patentable along with respective parent claims.

In summary, Claims 1-30 are believed to be allowable for the reasons given herein. Accordingly, these claims remain pending following entry of this Amendment, and are in condition for allowance at this time. As such, Applicant respectfully requests entry of the present Amendment and reconsideration of the application, with an early and

favorable decision being solicited. Should the Examiner believe that the prosecution of the application could be expedited, the Examiner is requested to call Applicant's undersigned attorney at the number listed below.

Respectfully submitted,
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MARKED-UP VERSION OF THE CLAIMS AS AMENDED IN AMENDMENT A

6. (Amended) The method of claim 5, wherein step (f) comprises the step of submitting an electronic payment using one of an automated clearing house network, a automated teller machine network, [a visa network, and a mastercard network.] and a credit card network.

21. (Amended) The system of claim 20, wherein said means for submitting submits an electronic payment using one of an automated clearing house network, a automated teller machine network, [a visa network, and a mastercard network.] and a credit card network.